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10/075,096	10/29/2001	Carl E. Whitcomb	WHIT/0002	7255

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STREETS & STEELE
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EXAMINER

NGUYEN, SON T

ART UNIT PAPER NUMBER

3643

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,096

Applicant(s)

WHITCOMB, CARL E.

Examiner

Son T. Nguyen

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-- **Th** MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 41** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the fabric" lacks prior antecedent basis.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1,2,4,13-16,18,19,29,30,41,46,48,49,53,63** rejected under 35 U.S.C. 102(b) as being anticipated by Berlit et al. (GB 2073567A).

For claims 1 & 48, Berlit et al. disclose a root growth barrier comprising a layer of a root-tip-trapping material 11,14 bonded to a layer of a root-impenetrable material 12,13.

For claim 2, Berlit et al. further disclose the root-impenetrable material is water-impenetrable (page 2, line 11, the material 112 is made out of a PVC material which is water impenetrable).

For claim 4, Berlit et al. further disclose the root-tip-trapping material being polypropylene which is a porous fabric.

For claim 13, Berlit et al. further disclose the porous fabric being opaque (page 1, lines 101-105).

For claim 14, Berlit et al. further disclose the porous fabric being black (page 1, line 103).

For claim 15, Berlit et al. further disclose laminating the materials 11,12,13,14 together (page 1, lines 127-130).

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For claim 16, Berlitz et al. further disclose the root-impenetrable material being a plurality of layers 12,13.

For claim 18, Berlitz et al. further disclose the root-impenetrable material being a polymer sheet (page 2, lines 1-11).

For claim 19, Berlitz et al. further disclose the root-impenetrable material being polypropylene (page 2, lines 1-2).

For claim 29, Berlitz et al. disclose an apparatus comprising a root-impenetrable material container 12,13 and a root-tip-trapping material 11,14 bonded to an inner wall of the container.

For claim 30, Berlitz et al. further discloses the container is formed into a shape as shown in fig. 1.

For claim 41, Berlitz et al. further discloses the root-tip-trapping material 11,14 being black (page 1, lines 100-105).

For claim 46, Berlitz et al. disclose a method of growing a plant in a pot 10 comprising the steps of disposing a bilayer root growth barrier consisting essentially of a root-tip-trapping inner material 11,14 bonded to a root-impenetrable material 12,13; disposing a growth medium adjacent to the root growth barrier; and adding a plant to the growth medium.

For claim 49, Berlitz et al. disclose a root growth barrier comprising a polymer sheet 12,13 having a surface bonded to a porous fabric 11,14.

For claim 53, Berlitz et al. disclose the fabric being polypropylene (page 2, lines 1-10).

For claim 63, Berlitz et al. further discloses the root-tip-trapping material being a plurality of strata 11,14.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 3,5-7,25,26,31,32,50,51,64,65** are rejected under 35 U.S.C. 103(a) as being unpatentable over Berlitz et al. (as above).

For claims 3 & 65, Berlitz et al. are silent about the root-tip-trapping material being greater than 10 or 100 root-tip-trapping elements per square inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the root-tip-trapping material of Berlitz et al. being greater than 10 or 100 root-tip-trapping elements per square inch, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect (how many roots one wishes to trap in the material) is achieved involves only routine skill in the art.

For claims 5,6,50, Berlitz et al. are silent about the porous fabric (polypropylene) having a certain or specific weight per square yard. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the porous fabric of Berlitz et al. be a certain or specific weight per square yard, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art.

For claims 7 & 51, Berlitz et al. are silent about the porous fabric (polypropylene) having openings between 1/16 and 1/4 inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the openings in the porous fabric of Berlitz et al. be between 1/16 and 1/4 inch, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect (how many roots one wishes to trap in the material) is achieved involves only routine skill in the art.

For claims 25,26, & 64, Berlitz et al. are silent about the root-impenetrable material having a certain or specific thickness. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the root-impenetrable material of Berlitz et al. be a certain or specific thickness, since it has been held that where routine testing and general experimental conditions are present,

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discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art. For claim 64, see explanation for claim 2 above.

For claims 31 & 32, Berlitz et al. are silent about the container having a certain or specific diameter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have container of Berlitz et al. be a certain or specific diameter, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect (for accommodating different size plants) is achieved involves only routine skill in the art.

7. **Claims 8-11,33-35,42,44,52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Berlitz et al. (as above) in view of Reiger (US 6202348).

For claims 8,33,52, it is uncertain if the polypropylene fabric of Berlitz et al. is a spun bonded, needle punched fabric or not. Reiger teaches a root barrier in which he employs a spun bonded needle punched porous fabric (col. 8, lines 64-67 and col. 9, lines 1-15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a spun bonded, needle punched fabric as taught by Reiger in place of the polypropylene porous fabric of Berlitz et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice, for both material will trap roots.

For claim 9, Berlitz et al. as modified by Reiger disclose polyester (Reiger, col. 9, line 8), polypropylene (Berlitz, page 2, lines 1-10) or olefin fiber (Reiger, col. 9, line 7).

For claims 10 & 42, in addition to the above, Reiger teaches woven fabric for the porous fabric (col. 6, line 50). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a woven fabric as taught by Reiger in place of the polypropylene porous fabric of Berlitz et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice, for both material will trap roots.

For claim 11, Berlit et al. as modified by Reiger (both) teach the porous fabric being degradable.

For claims 34 & 35, Berlit et al. as modified by Reiger are silent regarding certain or specific fabric density. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have certain or specific fabric density in the fabric of Berlit et al. as modified by Reiger, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art.

For claim 44, in addition to the above, Reiger teaches a container being a grow bag 10. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a grow bag as taught by Reiger in place of the container of Berlit et al. as modified by Reiger in order to provide ease of handling.

8. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Berlit as modified by Reiger as applied to claim 1 above, and further in view of Thomas (US 5311700). Berlit et al. as modified by Reiger are silent about the porous fabric being cotton. Thomas teaches a root growth barrier such as a container for a plant in which he employed cotton for a root-growth resistant material 50 (col. 5, line 11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ cotton as taught by Thomas as the preferred material for the porous fabric of Berlit et al. as modified by Reiger, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (to trap and resist root growth) as a matter of obvious design choice.

9. **Claims 17,21,22,24,54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Berlit et al. (as above) in view of Van der Goorbergh (EP 300578 A3).

For claim 17, Berlit et al. are silent about the root-impenetrable material being reflective. Van der Goorbergh teaches a seed trough having two layers 5,6 that are coated with a reflective material (page 2, col. 2, lines 7-16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a reflective material as taught by Van der Goorbergh on the root-impenetrable material of Berlit et al. in order to reflect light and thus prevent harm to the roots.

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For claims 21 & 22, in addition to the above, Van der Goorbergh further discloses aluminum foil (which is a metal foil) on the outer layer 6 of the plant container to reflect harmful light away from the plant (see abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ aluminum foil as taught by Van der Goorbergh as the preferred material for the root-impenetrable material of Berlitz et al. in order to reflect harmful light away from the plant.

For claims 24 & 54, in addition to the above, Van der Goorbergh further discloses the root-impenetrable material 6 being a polymer sheet and the sheet is white (col. 2, line 55 and col. 3, line 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a white polymer sheet as taught by Van der Goorbergh as the preferred material for the root-impenetrable material of Berlitz et al. in order to reflect harmful light away from the plant (col. 2, lines 54-55).

10. **Claims 20,23,27,28,36-40,55,56** are rejected under 35 U.S.C. 103(a) as being unpatentable over Berlitz et al. (as above) in view of Flasch, Jr. (US 5,852,896).

For claim 20, Berlitz et al. are silent about the root-impenetrable material being metal. Flasch, Jr. teaches a plant container comprising a root-impenetrable material 28 that is made out of metal (col. 12, line 38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ metal as taught by Flasch, Jr. as the preferred material for the root-impenetrable material of Berlitz et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (strength and durability features of metal) as a matter of obvious choice. In re Leshin, 125 USPQ 416.

For claim 23, in addition to the above, Flasch further teaches using a UV inhibitor to provide UV light stability (col. 12, line 45) in the preferred material for his root-impenetrable layer 28 to block out harmful UV light or radiation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a UV inhibitors to provide high UV stability as taught by Flasch, Jr. in the root-impenetrable layer of R Berlitz et al. in order to block out harmful UV light or radiation.

For claims 27,28, Berlitz et al. is silent about the root-impenetrable material being biodegradable. In addition to the above, Flasch further discloses the root-impenetrable

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material 6 being biodegradable (col. 12, line 38, where Flasch discusses the material can be wood which is biodegradable). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ wood as taught by Flasch as the preferred material for the root-impenetrable material of Berlitz et al. because wood is biodegradable and environmentally friendly.

For claims 36 & 55, in addition to the above, Flasch further discloses the container being made out of polyethylene (col. 12, line 44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ polyethylene as taught by Flasch as the preferred material for the container 125 of Berlitz et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. Note, Berlitz et al. teach laminating as explained in the above.

For claims 37,38,56, Berlitz et al. as modified by Flasch are silent about the polyethylene having a thickness between 2 and 10 mils or between 3 and 5 mils. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the thickness of the polyethylene of Berlitz et al. as modified by Flasch being between 2 and 10 mils or between 3 and 5 mils, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges involves only routine skill in the art.

For claims 39,40, in addition to the above, Flasch further teaches using a UV inhibitor to provide UV light stability (col. 12, line 45) in the preferred material for his root-impenetrable layer 28 to block out harmful UV light or radiation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a UV inhibitors to provide high UV stability as taught by Flasch, Jr. in the polyethylene of Berlitz et al. as modified by Flasch in order to block out harmful UV light or radiation.

11. **Claim 43** is rejected under 35 U.S.C. 103(a) as being unpatentable over Berlitz et al. (as above) in view of Kalpin (US 3,094,810). Berlitz et al. are silent about the container being assembled by sewing. Kalpin teaches a container for plant made out of semi-rigid sheets of material such as paper or cloth that are sewed together to form the

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container (col. 1, lines 62-71). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a container made up of semi-rigid sheets that are sewed together as taught by Kalpin in place of the container of Berlitz et al. in order to provide a container that is easy to store and reduce shipping costs (col. 1, lines 13-15 of Kalpin).

12. **Claim 45** is rejected under 35 U.S.C. 103(a) as being unpatentable over Berlitz as modified by Reiger as applied to claim 33 above, and further in view of Billings (US 6,223,466 B1). Berlitz et al. as modified by Reiger are silent about the container being a production pot in pot-in-pot production. Billings teaches a planting system that is a production pot-in-pot in which a primary pot 20 is installed in a soil and a second pot 12 is inserted into the primary pot for purpose of growing a tree or shrub (see abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the container of Berlitz et al. as modified by Reiger be a production pot in pot-in-pot production as taught by Billings in order to allow a user with the versatility of placing and removing the inner pot from the outer pot whenever desired and to interchanged from one location to another location by replacing one inner container from an outer container with another similar inner container (see abstract of Billings).

13. **Claims 47,57,59,60-62** are rejected under 35 U.S.C. 103(a) as being unpatentable over Berlitz et al. (as above) in view of Reiger (as above) and Flasch (as above). See the above for explanation. The biodegradable concept and polyethylene are taught by Flasch and the in ground and spun bonded needle punched fabric are taught by Reiger (col. 4, lines 4-38).

14. **Claim 58** is rejected under 35 U.S.C. 103(a) as being unpatentable over Berlitz as modified by Reiger and Flasch as applied to claim 57 above, and further in view of Van der Goorbergh (as above). See the above for explanation. Van der Goorbergh teaches white outer sheet.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is (703) 305-

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0765. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 872-9325. The official fax number is 703-872-9306.



Son T. Nguyen
Primary Examiner, GAU 3643
October 02, 2003